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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,747	12/19/2001	Stuart Edwards	9222.16399-D DIV	4434

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07/09/2003

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,747

Applicant(s)

EDWARDS ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Applicant's amendments and comments, received June 2, 2003, have been fully considered by the examiner. In particular, the addition of newly filed claims 2-7 is acknowledged. The following is a complete response to the June 2, 2003 communication.

Information Disclosure Statement

Regarding applicant's request to consider references listed on a page submitted with the December 19, 2001 IDS (a copy of which is listed as "Attachment A" in applicant's June 2, 2003 response), these references have been considered by the examiner and are listed on the PTO-892 which accompanied the Office action of Paper No. 3 (mailed November 29, 2002).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As amended, the scope of the claims is unclear. In particular, the preamble of Claim 1 recites "An interface for association with an electrode structure" which implies that the interface, and not the electrode, is the invention. However, the body of the claim recites "a sensor associated with the electrode structure". As such, it is unclear if the scope of the claim is limited to the interface, per se, as suggested by the preamble,

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or to the combination of the interface and the electrode structure. Clarification is necessary.

Also, it is noted that claim 4 contains a typographical error with the redundant phrase "to process to process" in line 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Wayne et al ('581) in view of the teaching of Mackey ('835).

Wayne et al provide a system which includes an electrode catheter instrument (18) which is inserted into the body. Wayne et al also provide a graphical user interface (GUI) which includes an input (30) adapted to be attached to the instrument and/or sensor, a display screen (38) and an operating system (28) which provides image and information data to the display. Wayne et al fail to specifically disclose the use of temperature sensors and the display of temperature data. It is again noted that this language is confusing in the claims as written and the scope of the claims is unclear.

Mackey discloses an analogous RF treatment system whereby a GUI is used to represent current data of an RF treatment system. In particular, Mackey specifically

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teaches the use of temperature sensors for controlling the delivery of energy to the electrodes (Abstract). Moreover, Mackey teach that the various electrode and ablation parameters, which would inherently include temperature, may be displayed using the GUI (col. 12, lines 40+). Mackey further disclose the data may be saved to disk (i.e. storage medium). The examiner maintains that the various forms of displays used in GUI's, such as numeric display, graphs, color displays, etc., are well known to those of ordinary skill in the art. Also, the use of a printer to print out data is deemed an obvious addition in such a computer controlled system. Additional references showing such obvious peripherals/visuals are not deemed necessary.

To have provided the Whayne et al system with temperature sensors associated with the electrodes and means to display the monitored temperature on the GUI to keep the user aware of the operating temperature of the device is deemed to be an obvious modification for one of ordinary skill in the art, particularly since Mackey teaches that it is known to monitor and display temperature parameters in an RF ablation system.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 is rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 6,358,245 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a graphical user interface for displaying image data corresponding to an electrode device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1-52 of U. S. Patent No. 6,273,886 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a graphical user interface for displaying image data corresponding to an electrode device.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

Applicant's arguments, filed June 2, 2003, are not deemed persuasive. In particular, applicant asserts that the instant application has an effective filing date of February 19, 1998 via a claim for priority to US Serial No. 09/026,296 (now US Patent No. 6,009,877). However, there is no support for the claimed subject matter of the instant application claims in the '877 patent. While the '877 patent does disclose a display means, there is no disclosure of the specific operating system for generating viewable images comprising an idealized image of the electrode structure as set forth in claim 1. As such, the effective filing date of the instant application is not deemed to extend to the February 19, 1998 date and the Whayne et al reference is deemed to be prior art under 35 USC 102(e) and therefore, as now applied, under 35 USC 103.

Also, regarding the double patenting rejection involving US Patent No. 6,273,886, it is the examiner's assertion that the '886 patent does specifically claim the viewable image of the electrode respondent to the temperature sensor as set forth in claim 1. See, for example, claims 36 and 37 of the '886 patent. As such, the examiner maintains that the double patenting rejection is proper and is maintained.

Applicant's arguments with respect to the double patenting rejection involving US Patent No. 6,358,245 are persuasive and that rejection has been withdrawn.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

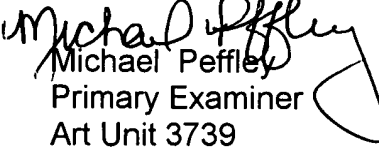
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Michael Peffley
Primary Examiner
Art Unit 3739

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July 9, 2003